



UNITED STATES PATENT AND TRADEMARK OFFICE

Wk

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,044	06/23/2000	John Bronskill	203560	9040
45809	7590	08/18/2006	EXAMINER	
SHOOK, HARDY & BACON L.L.P. (c/o MICROSOFT CORPORATION) INTELLECTUAL PROPERTY DEPARTMENT 2555 GRAND BOULEVARD KANSAS CITY, MO 64108-2613			BRIER, JEFFERY A	
			ART UNIT	PAPER NUMBER
			2628	
DATE MAILED: 08/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/602,044		BRONSKILL ET AL.	
	Examiner		Art Unit	
	Jeffery A. Brier		2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 6/6/2006 has been entered.

Response to Arguments

2. Applicant's arguments filed 6/6/2006 have been fully considered but they are not persuasive. These arguments are addressed under the same heading used by applicant.

Rejections based on 35 U.S.C. 101

The argument concerning the 35 U.S.C. 101 rejection is not persuasive because the amendments to both claims 19 and 38 do not limit the claims to a computer readable medium that is not a signal. Claiming in claim 19 the computer readable medium has a tangible component and claiming in claim 38 the computer readable media has one or more tangible components does not claim the computer executable instructions are stored in the tangible component or the plurality of modules are stored in the one or more tangible components. See ANNEX IV in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility at pages 50-57. http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf.

Claim 38 additionally does not claim a computer is responding to the modules to perform the claimed functions. Thus, the claim is a computer program per se as well as a signal.

Art Unit: 2628

Rejections based on 35 U.S.C. 112, first paragraph

The argument concerning the 35 U.S.C. 112, first paragraph, rejection is not persuasive because the specification at page 26 lines 6-7 clearly differentiates between rendering and displaying because at this section of the specification rendering is performed and then the rendered brush stroke is output. Thus, "rendering" in light of the specification is not displaying. The claim term "output" in light of the specification is not displaying since it has not been given a definite definition and since "output" includes the abstract data "output" of the rendering module which lacks a tangible and useful result.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 19-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 19-39:

These claims claim carrier wave signals as a computer readable medium (media) because applicants specification at page 9 lines 7-14 define computer readable medium (media) as carrier wave. Lines 9-10 defines computer readable medium (media) as "or method for information storage such as computer instruction, data structures, program modules and the like" and lines 13-14 equates computer instructions, data structures,

Art Unit: 2628

program modules or data in a modulated data signal such as a carrier wave. Therefore, the specification defines computer readable medium (media) as a carrier wave. Thus, when the claims are read in light of the specification claims 19-37 claim a carrier wave computer readable medium (media). The modules of claims 38 and 39 are program modules without claiming any device, processor, computer, etc. performing the function associated with the module, see applicants specification at page 9 lines 15-17. Thus, when claims 38 and 39 are read in light of the specification they claim a carrier wave computer readable medium (media). In ANNEX IV Computer-Related Nonstatutory Subject Matter of the Interim guidelines a signal is held to be nonstatutory subject matter and since applicants carrier wave is a signal then these claims are nonstatutory.

Claims 38 and 39:

The modules of this claim are program modules without claiming any computer for performing the function associated with the module, see applicants specification at page 9 lines 15-17 which defines modules as programs.

A number of program modules may be stored on the hard disk, magnetic disk 29, optical disk 31, ROM 24 or RAM 25, including an operating system 35, one or more applications programs 36, other program modules 37, and program data 38.

Therefore, these claims are nonstatutory since they are programs per se.

Applicant should note that amendments to the specification, such as deletion, may introduce new matter into the specification. Thus, an appropriate amendment to the claims is necessary to make the claims statutory.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 19 were previously amended to claim "displaying the first segment of the brush stroke on a display device" which does not have clear support in the specification. The specification discusses rendering but rendering is different than displaying, thus, applicants originally filed application fails to convey "displaying the first segment of the brush stroke on a display device". The specification also does not describe when the rendered brush stroke is displayed if it is displayed. Note the specification at page 1 lines 5-7 and pages 23-26. Claim 38 was previously amended to claim "for displaying the brush stroke on a display device". The discussion given for claims 1 and 19 apply to this claim.

7. Applicant should note if the displaying step is deleted from the claim then the claims will lack a concrete, useful, and tangible result.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

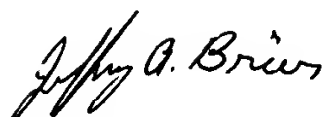
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2628

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffery A Brier
Primary Examiner
Division 2628